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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,637	08/07/2001	Larry Bowen	00417.00003	9687

22907 7590 02/05/2003

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WASHINGTON, DC 20001

EXAMINER

WALLS, DIONNE A

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 02/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/922,637

Applicant(s)

BOWEN ET AL.

Examiner

Dionne A. Walls

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 110-130 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 110-130 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of the invention of Group II, claims 110-130, in Paper No. 5 is acknowledged. Because Applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 116-119 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 116 recites the limitation "said oxygen storage component" in line 4. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical

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Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the ALPA (pre-ALPA 35 U.S.C. 102(e)).

6. Claims 110-130 rejected under 35 U.S.C. 102(e) as being anticipated by Snaidr et al (US. Pat. No. 6,371,127)

The applied reference has common inventors with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Snaidr discloses all that is recited in the claims (see col. 7, lines 54-66; col. 9, line 65-col. 10, line 33; col. 17, line 60-col. 18, line 59; col. 19, lines 2-4; col. 20, lines 42-57).

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 110-113 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito (US. Pat. No. 4,915,117).

Ito discloses a sheet for holding tobacco, said sheet formed of ceramic fibers which may include zirconia, alumina or titanium oxide (corresponding to the claimed "non-combustible material/oxygen storage component/group IVB metal oxide/catalyst"); glass fiber (corresponding to the claimed "sheet reinforcement"), singly or in combination with aluminoborosilicate (corresponding to the claimed "oxygen storage component/catalyst/aluminum silicates"); a binder, which can be either organic or inorganic and can consist of starch, silica gel, rubber-type adhesives or natural resins (which also corresponds to the claimed "sorber/porous metal oxide/plastic/cellulose materials"); and cellulose pulp fiber (corresponding to the claimed "organics"). The sheet comprised of such fibers/additives such that upon smoking of the cigarette having the sheet as a wrapper, no harmful organic substances are produced (corresponding to the claimed "activating said sheet material...at a temperature of a high temperature cigarette burn zone") (see entire patent). While there may be no explicit statement that the cellulosic pulp fiber or organic binder is combustible at the high-temperature cigarette burn zone, it would follow that since the cellulosic pulp/organic binder is derived from a cellulose/wood source (which are themselves combustible materials) said materials would, obviously, also burn or combust when subjected to high-temperatures.

***Allowable Subject Matter***

3. The indicated allowability of claims 114, 115, 119 and 122 is withdrawn in view of the newly discovered reference to Snair et al (US. Pat. No. 6,371,127). Rejections based on the newly cited reference are stated above, in paragraph 6.

***Response to Arguments***

4. Applicant's arguments filed October 21<sup>st</sup>, 2002 have been fully considered but they are not persuasive.

- Applicant argues that Ito clearly does not disclose a cigarette that has organics that are combusted when the cigarette is burning, as recited in the claims, since the "organics" that Ito believes cause the above-mentioned problems are removed long before the cigarette is ever smoked. However, the examiner disagrees and believes that Ito's constituent of cellulose pulp fibers is what corresponds to the claimed "organics". Specifically, Ito claims a cigarette comprising a thin sheet for holding tobacco, said thin sheet comprising a mixture of wood pulp (organic) and ceramic fibers. It follows that the organic portion, i.e. wood pulp, of the cigarette sheet would burn during smoking. The Examiner finds no indication in Ito of an intent to "remove" all the organics from said sheet before the wrapper is applied to the smoking rod and prior to the smoking article being smoked. All that the Examiner believes is disclosed by Ito is the formation of a cigarette sheet that produces no harmful organic substances from the paper fiber which it includes because the organic fibers have been "thermally decomposed", which is a completely different issue from organic material that has been "removed". Examiner contends that the organic material is still there, since "thermal decomposition" does not involve combustion (just heating in absence of air); therefore, upon subsequent burning/combusting of the sheet, the resulting organic material is unable to produce harmful organic substances. Therefore, since the Examiner believes that even after thermal decomposition, organic material is still present, it follows that

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such material will burn, even though harmful substances may no longer be produced.

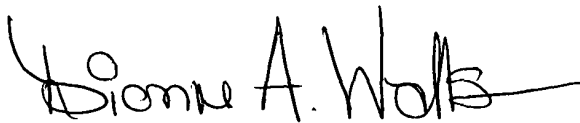
The rejection of claims 110-113 over the Ito reference is still considered proper.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (703) 305-0933. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

A handwritten signature in black ink that reads "Dionne A. Walls". The signature is stylized with a large, looped initial "D" and a long horizontal stroke at the end.

Dionne A. Walls  
January 27, 2003